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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/119,626	07/21/1998	MASASHI GOTOH	0083-0865-2	1291

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EXAMINER

CUNEO, KAMAND

ART UNIT PAPER NUMBER

2827

DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

9/119626

Applicant(s)

Examiner

Cuneo

Group Art Unit

2827

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 4/12/02
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 16-26 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 16-18 is/are allowed.
- ☒ Claim(s) 19-26 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

DETAILED ACTION

Treatment of Claims Based on Language

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 22-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not set forth what elements compose the "means for evenly distributing ultrasonic energy." Is the means the conductive pattern with the groove? If so, which grooves? Are all of the grooves required? Does the means include the notch not extending into the board main body? etc. Due to the great deal of uncertainty regarding the means, art cannot be applied to these claims. Nevertheless, applicant is encourage to review the rejection for claim 19, which includes grooves in the conductive pattern, and the reasons for allowance for claim 16, which includes the further refinement of the grooves not extending in the board main body, for guidance on the teaching of the prior art.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 22-26 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- See the section above. Due to the uncertainty in the means language, the scope of the claim is indefinite.

Treatment of Claims Based on Prior Art

5. 35 USC 103(a) states:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Obviousness under 35 USC 103(a) is determined against a background established by the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), which are summarized in items 1-4 below.

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 USC 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 USC 103© and potential 35 USC 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 19-21 are rejected under 35 USC 103(a) as being unpatentable over Applicant's figure 11 and Mims (US 3893223).

Figure 11 of the present application disclose all of the elements of claims except for two grooves proximate a bonding areas to place the area therebetween. Since applicant has elected species a1, the grooves are interpreted to mean isolated notches or recesses.

Mims teaches to place grooves (with the conductive material all the way removed) on either side of a bonding area where a row of bonding areas is being ultrasonically attached. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to place grooves between the bonding areas of figure 11, as taught by Mims, to prevent "breaking an adjacent and previously made weld," Mims at column 2, line 54. Mims also teaches that the grooves should extend perpendicular to the direction of the vibration. Also note that the grooves of Mims do not isolate the metal pattern.

Allowable Subject Matter

8. Claims 16-18 are allowed. While there is a teaching to place the grooves in the conductive pattern to prevent breakage of adjacent bonds, the prior art does not teach this configuration to the specificity described in claim 16 which is the grooves extending in the conductor, but not in the board main body in the configuration combined with the other claim elements.

Response to Arguments

9. Applicant's arguments are moot in view of the new grounds of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Closing

11. Any inquiries related to the examination of this application should be directed to Ex. K. Cuneo at (703) 308-1233 or her supervisor Ex. J Gaffin at (703) 308-3301. Inquiries of a general nature should be directed to the receptionist of Group 2800 at (703) 308-0956. The fax numbers for Group 2800 are (703) 305-7722 and 7724.



K. Cuneo
Primary Examiner Group 2841
June 30, 2002